REMARKS

Independent claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ball and Starnes. Reconsideration of the rejection is requested.

To establish *prima facie* obviousness the examiner must show that some objective teaching, suggestion or motivation in the applied prior art taken as a whole would have led a person of ordinary skill in the art to the claimed invention as a whole, including each and every limitation of the claims, arranged as required by the claims, without reference to the appellant's disclosure. *See generally, In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Fritch*, 972 F.2d 1260, 1265-66, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); *In re Oetiker*, 997 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Laskowski*, 871 F.2d 115, 10 USPQ2d 1397 (Fed. Cir. 1989); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988).

The applied art fails to disclose all of the limitations of independent claim 8 arranged as required by the claims. Claim 8 calls for an article comprising a medium for storing instructions that enable a processor-based system to... provide a graphical user interface of a navigation bar with a subtract button image, the subtract button image selectable to toggle between indicating the difference between the cached and current versions (of an Internet web page) and indicating the current version. The examiner correctly states that Ball fails to disclose a single selectable subtract button image for toggling between two pages. Paper No. 19, page 2. Likewise, Ball fails to disclose a graphical user interface of a navigation bar with a subtract button image. *See, e.g.*, Figure 12. The command bar and mode button of Starnes fails to cure the deficiencies of Ball.

Starnes' command bar and mode button are not tantamount to a graphical user interface of a navigation bar with a subtract button image. That is, Starnes does not toggle between two Internet web pages and the mode button does not act like a subtract button. For example, in Starnes a single web page is provided because a content server is only accessed once when forwarding an HTML file to a browser. *See* column 15, lines

25-38; column 16, lines 1-19; Figure 1; Figure 4 at 402-404; Figure 5A at 502-506. Specifically, after receiving and displaying the requested HTML file, the browser sends get image requests to a proxy server. Column 15, lines 37-43. The proxy server forwards the image files in either an accelerated (compressed) or original (uncompressed) state. *See, e.g.,* Figure 5B.

The proxy server adds the command bar to the HTML file after it is received from the content server. Column 18, lines 24-58. Thereafter, the HTML file including the command bar is forwarded to the browser. *Id.* Thus, the browser receives the HTML document and command bar before the browser makes the get image requests. *Id. See also,* Figures 4 and 5A.

The command bar allows a user to request original images when the proxy server has initially provided accelerated images. *Id.* Notably, after receipt of the requested HTML document, subsequent or multiple get image requests cause the browser to receive and display image files without making a request for a different HTML file. *See, e.g.,* column 15, lines 55-67; Figure 4 at 410-414. That is, when accelerated images are being displayed, the browser sends get image requests for original image files. Column 18, lines 24-59. But, because original versions of the image files are stored in the image store, the content server is not accessed at that time. *See* column 16, lines 33-50; column 17, lines 45-column 18, line 19. In other words, original image files are stored on the image store after the browser makes the initial HTTP request. *See, e.g.,* Figure 5A at 514. If an original file is not stored on the image store then the image file was not previously requested. Column 18, lines 1-19. Therefore, when the mode button is selected the content server is not accessed. Without subsequent access, the web page being displayed remains the same page as initially requested. In this way, Starnes does not toggle between two different Internet web pages much less pages that have different text.

In contrast, Ball copies web pages from the World Wide Web, monitors the pages for changes (at a later time), and archives the changes to the pages. *See, e.g.,* column 3, lines 13-35; column 4, lines 14-64. The user in Ball may compare the *text* of selected

versions of the page. *Id. See also* column 20, lines 26-53. Therefore, Ball's versions of a web page are separated temporally and are textually different. Because Starnes does not access the content server more than once, Starnes does not obtain two different Internet web pages. As such, neither Ball nor Starnes disclose a navigation bar with a subtract button image, the subtract button image selectable to toggle between indicating the differences between cached and current versions and indicating the current version. Without a teaching of all limitations, *prima facie* obviousness has not been established.

There is no suggestion, motivation, or teaching in Ball and Starnes of the desirability to do what the applicant has done. Without some suggestion, motivation, or teaching of the desirability of making an applicant's specific combination, obviousness has not been established. *See In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313, 1313, 1316-17 (Fed. Cir. 2000).

As explained above, selecting Starnes' mode button does not cause toggling between two Internet web pages. Thus, Starnes' button does not behave like the claimed button as asserted in the Office action. *See* Paper No. 19, page 3. Likewise, Ball's DIFF link does not behave like Starnes' mode button. For example, the DIFF link may invoke htmldiff. Column 20, lines 26-53; Figure 12. Htmldiff compares the *text* of two HTML pages. Column 20, lines 6-17. In other words, due to the limitations of htmldiff, differences such as changes in the content of an image file may be ignored. *Id.* Because differencing in Ball may ignore changes in image files (especially where the URL of a file has not changed) and Starnes gets images files upon selection of the mode button, the references do not behave in the same way and even teach away from each other. Thus, there is simply no suggestion of providing a selectable button image of minus sign to toggle between differences between a cached version and current version of an Internet web page and the current version of the page.

In sum, because Ball and Starnes do not teach all of the limitations of independent claim 8, and there is no suggestion, motivation, or teaching of doing what the applicant has done, *prima facie* obviousness has not been established. Under a similar analysis, *prima facie* obviousness has not been established with respect to independent claim 15.

Because *prima facie* obviousness has not been established for independent claims 8 and 15, it also has not been established for claims dependent thereon.

As amended, independent claim 29 calls for upon initial receipt of a current version of an Internet web page, automatically displaying an indication of the difference between the current version and a cached version of the page, and toggling between displaying the indication of the difference and displaying said current page, said toggling in response to user selection of a single button on a graphical user interface of a navigation bar.

As explained above, Ball and Starnes fail to teach or suggest a graphical user interface of a navigation bar with a subtract button image, the subtract button image selectable to toggle between indicating the difference between the cached and current versions (of an Internet web page) and indicating the current version. For at least the same reasons, Ball and Starnes fail to teach or suggest toggling between displaying the indication of the difference and displaying said current page, the toggling in response to user selection of a single button on a graphical user interface of a navigation bar.

Also, Ball and Starnes fail to teach or suggest upon initial receipt of a current version of an Internet web page, automatically displaying an indication of the difference between the current version and a cached version of the page. For example, with respect to canceled claim 33, the examiner stated "users of Ball's invention can cause the indication of the differences to be displayed upon receipt of the current version by clicking on the "DIFF" button." Paper No. 19, page 4. It is respectfully submitted that Ball does not receive a current version of an Internet web page and automatically, *upon initial receipt of the page*, show the difference between a cached and a current version of the web page.

Pursuant to Ball, copies of pages are archived in a location that is separate from where the original pages reside on the World Wide Web. Column 3, lines 17-35. At later times, the pages are monitored for changes and the changes are also archived. *Id.* Thus,

when the user accesses a hot-listed page, the user *receives the current version* of the page and an option to compare selected versions of the page. *Id.*

In contrast, in some embodiments of the present invention the user may initially be presented with a page that automatically provides an indication of the differences between a cached version and a current version of an Internet web page. *See, e.g.,* specification, page 5, lines 15-24. In this way, the differencing functionality does not have to be selected to see the difference, yet uninterrupted viewing of the current version of the web page is allowed. The examiner has failed to show such a feature in Ball. Accordingly, *prima facie* obviousness has not been established.

CONCLUSION

As discussed above Ball and Starnes do not teach all of the limitations of independent claims 8, 15, and 29 and claims dependent thereon. Also, there is no suggestion, teaching, or motivation of the desirability to do what the applicant has done. Thus, *prima facie* obviousness has not been established; withdrawal of the rejections and allowance is requested.

The commissioner is authorized to charge any additional fees, including extension of time fees, or credit any overpayment to Deposit Account No. 20-1504 (ITL.0314US).

Respectfully submitted,

Date: <u>November 29, 2004</u>

Rhonda L. Sheldon, Reg. No. 50,457
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Suite 100
Houston, TX 77024
713/468-8880 [Phone]
713/468-8883 [Fax]

Customer No.: 21906